(1) Supreme Court, U.S.
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IN THE

Supreme Court of the United States

NORTHERN LIGHTS CLUB, 641271 ALBERTA, LTD., d/b/a NORTHERN LIGHTS CLUB, AND JEFFREY K. BURGAR,
Petitioners

v.

NORTHERN LIGHT TECHNOLOGY, INC.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals For The First Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

1. **"Second Service" In the Courtroom:** If a defendant attends a live, court-noticed FED. R. CIV. P. 12(b)(2) hearing, and enters the forum to assert the defense of lack of personal jurisdiction, but plaintiff attempts a "second service" of summons in the courtroom, does defendant thereby lose the very defense that induced him to be present, or may defendant press his defense?

2. **"Second Service" – Constitutional Due Process:** Does assertion of personal jurisdiction, when minimum contacts are otherwise lacking, based on in-courtroom "second service," violate either prong of the applicable Due Process standard – "minimum contacts" among the defendant, forum and cause of action, or "fair play and substantial justice?"

3. **"Second Service" – General Rule of Process Immunity:** Does in-courtroom "second service" violate the traditional rule that parties, lawyers, and witnesses are immune from service of process while attending court and for a reasonable time traveling to and returning from court?

4. **Process Immunity – State or Federal Law?:** Is the traditional rule of process immunity a matter of state law for individual states to define or is it a federal matter?

5. **Process Immunity – Governing Law In Federal Question Cases:** When a plaintiff – in a suit founded on a federal question and not on diversity, but in which the federal statute itself (here, the Lanham Trademark Act), in relevant part, does not authorize service other than in accordance with FED. R. CIV. P. 4(k)(1)(A), 4(e) and 4(f) – attempts to perform service under state procedures "borrowed" by FED. R. CIV. P. 4(k)(1)(A) and 4(e)(1), is process immunity governed by state or federal law?

6. **Process Immunity – Voluntariness Exception?:** If Massachusetts rejects a "voluntariness" exception to process immunity, such that parties, lawyers, and witnesses on court business are immune "whether they attend on summons or voluntarily, and whether they have or have not obtained a writ of protection," did the First Circuit err by predicating jurisdiction upon a defendant's "[voluntary] [entry] into Massachusetts" (emphasis in original)?

7. **Process Immunity – "Same Case" Exception?:** If Massachusetts never has recognized a "same or related case" exception to process immunity, then does *Lamb v. Schmitt*, 285 U.S. 222 (1932) (Mississippi case), impose a "same case" exception on Massachusetts, requiring defendants to seek a protective order to attend a hearing, and imposing "a relatively heavy presumption" against such orders even if sought?

8. **Process Immunity – "Same Case" Retroactivity:** Was the First Circuit's retroactive application of this "same case" exception, without advance notice of the change, in error?

9. **Process Immunity – "Protective Order" Exception?:** If Massachusetts rejects a "protective order" exception to process immunity, and parties on court business are immune "whether they attend on summons or voluntarily, and whether they have or have not obtained a writ of protection," then did the First Circuit err by stripping a defendant of the defense of lack of personal jurisdiction for failing to obtain a advance permission to participate in an hearing on this very defense?

10. **Process Immunity – Protective Order Rule Retroactivity:** Did the First Circuit err by reversing prior law retroactively, and applying the new "protective order" rule without fair notice or warning of the change?

11. **Process Immunity – Split Between First and Second Circuits:** The Second Circuit, e.g., *Shapiro & Son Curtain Corp. v. Glass*, 348 F.2d 460 (2nd Cir. 1965), and other Federal courts interpreting *Lamb v. Schmitt*, have concluded that *Lamb* does not establish the blanket exception the First Circuit claims it does. Because the First Circuit created a circuit split, see 236 F.3d at 62 n.9 (App, *infra*, 10a n.9), by rejecting the Second Circuit's view, how will this Court resolve the circuit split?

12. **Internet Due Process -- Website Visibility:** When an Internet Website publisher hosts that site on a "server" computer outside the United States, does the visibility of Website content from plaintiff's preferred jurisdiction (just as the same content is visible everywhere else in the world) supply sufficient jurisdictional contacts with the forum, or would jurisdiction over the publisher offend due process?

13. **Internet Due Process – Passive / Active "Sliding Scale:"** If a Website publisher's content is hosted on a foreign "server," are the requirements of due process satisfied if the trial court, on the basis of Website content (presumably, visible everywhere) characterizes the site as "not merely a passive one" – as opposed, evidently, to a "perfectly passive" Website?

14. **Internet Due Process – Split Among Circuits:** If Website "content" is proffered as a basis for jurisdiction, do traditional due process standards govern, as was held in *GTE New Media Servs. v. Bellsouth Corp.*, 199 F.3d 1343, 1349-50 (D.C. Cir. 2000); see also *Bensusan Restaurant Corp. v. King*, 126 F.3d 25 (2nd Cir. 1997), or should courts follow the novel "sliding scale" approach favored by the Fifth and Tenth circuits, see *Mink v. AAAA Development LLC*, 190 F.3d 333 (5th Cir. 1999); *Soma Medical Intern. v. Standard Cht'd Bank*, 196 F.3d 1292 (10th Cir.1999), or does some other standard govern?

15. **Due Process – Injunction Against Foreign Defendant:** Did assertion in this case of content control over a Website published abroad, by enjoining the persons of its Canadian publishers, violate the Due Process Clauses of the Constitution?

16. **Scope of Injunction – Equitable Balancing Rule:** If a trial court considers three design elements of a Website "homepage" potentially objectionable – and it is presented with concrete, less-restrictive alternatives to its preliminary injunction (each fully satisfying all its stated concerns) – seven, six, and three months, respectively, prior to the March 31, 2000 decision (appealable under 28 U.S.C. § 1292(a)(1)) granting, continuing and/or refusing to dissolve or modify the injunction – then does the injunction violate common-law and equitable standards requiring a close fit between the purpose and terms of any injunction, because the injunction (1) unnecessarily assumes complete content control over the homepage, (2) blacks out all content previously appearing there, and (3) dictates the entire substantive content that the publishers unwillingly must publish and subsidize?

17. **Scope of Injunction – "Forced Speech" First Amendment Violation:** If the trial court's March 31, 2000 decision to impose (or to refuse to modify) an injunction dictates the entire substantive content of the Website "homepage," then does it violate the prohibition against "forced speech" set forth in such cases as *Wooley v. Maynard*, 430 U.S. 705, 714 (1977), and *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 573 (1995)?

18. **Scope of Injunction – "Strict Scrutiny" of Content-Based Speech Restrictions:** If an injunction unnecessarily (despite less-restrictive alternatives) assumes content control over a Website "homepage" and dictates its entire substantive content, then does the injunction violate the rule of *Perry*

Education Assn. v. Perry Local Educators' Assn., 460 U.S. 37, 45 (1983), *Simon & Schuster, Inc. v. Crime Victims Bd. of New York*, 502 U.S. 105, 115-18 (1992), and other cases, that content-based speech restrictions must be narrowly drawn and necessary and to serve a compelling state interest?

19. **Scope of Injunction – Heightened Scrutiny of Speech-Regulating Injunctions:** If an injunction unnecessarily (despite known alternatives) dictates the entire substantive content of a Website "homepage," then does it violate the rule of *Madsen v. Women's Health Ctr., Inc.*, 512 U.S. 753 (1994), that all injunctions (even content-neutral ones that only incidentally burden speech) must "burden no more speech than necessary to serve a significant government interest?"

20. **Scope of Injunction – Failure of Appellate Court to Exercise Supervision Over Preliminary Injunction Despite Proper 28 U.S.C. § 1292(a)(1) Appeal:** If challenges to the imposition and scope of a preliminary injunction are the very reason for an interlocutory appeal under 28 U.S.C. § 1292(a)(1), and the appeals court acknowledges these issues "have been raised below," such that "we do not find waiver," and it does "not preclud[e] further consideration" at trial, then should the court correct the continuing daily violation of the defendants' First Amendment and general equitable rights, or may it fail to correct error by remanding with instructions that issues "can be argued in the trial on the merits?"

21. **Anticybersquatting Consumer Protection Act "Objective Reasonableness" Defense – Statutory Interpretation:** In light of the alternatives: e.g., (1) one resembling the "objective reasonableness" defense in qualified immunity cases such as *Anderson v. Creighton*, 483 U.S. 635 (1987), or (2) a burden-shifting framework as in *McDonnell-Douglas Corp. v. Green*, 411 U.S. 792 (1973), or (3) by

reference to state law "bad faith" insurance torts, or (4) some other legal framework – how should the "objective reasonableness" defense established in 15 U.S.C. § 1125(d)(1)(b)(ii), as a legal matter, be interpreted and applied?

22. **ACPA "Objective Reasonableness" – Method of Raising Defense:** Have the courts below misapplied the "objective reasonableness" defense by denying the very existence of defendants' subjective beliefs instead of considering whether those beliefs are objectively reasonable?

23. **ACPA – Failure to Address Changed Circumstances When Predicating Injunction On ACPA Violation:** Did the trial court and the First Circuit err by attempting to apply the ACPA to factual circumstances that had ceased to exist more than three months before the ACPA was signed into law, instead of predicating their injunction analysis on facts as they existed at the time of the trial court's March 31, 2000 decision?

24. **Injunctive Relief -- Changed Circumstances:** Did the First Circuit err by failing to dissolve or modify an injunction issued by the trial court on March 31, 2000, based on the assumption that nothing had changed in the time between September 1, 1999, and March 31, 2000, thereby freezing matters "at the time of commencement of the action" instead of considering changes during the intervening seven months?

Parties to Proceeding

641271 Alberta, Ltd., d/b/a Northern Lights Club – A Canadian corporation[1] headquartered in High Prairie, Alberta, Canada, whose stock is not traded on any public exchange. 641271 Alberta, Ltd., has no corporate parent and therefore no shares are traded on any public exchange.

Mr. Jeffrey K. Burgar – A natural person residing in High Prairie, Alberta, Canada.

Northern Light Technology, Inc. – A corporation headquartered in Cambridge, Massachusetts, whose stock is not traded on any public exchange. On or about September 11, 2000, counsel for Northern Light Technology ("NLT") certified to the court of appeals that NLT is a private corporation without any corporate parent and that no public companies own 10% or more of NLT's stock. Petitioners have no reason to believe these facts have changed since September 11, 2000.

Northern Lights Club – A d/b/a of 641271 Alberta, originally adopted to simplify Network Solutions, Inc. ("NSI") renewal billing. Among other reasons,[2] bills addressed to "[Name] Club" signify through the envelope addressing window which bills have come due. This convention also facilitates certain functions that NSI's billing system, at one time, could not handle without a unique registrant for each Domain Name.

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[1]Because of certain aspects of Canadian corporation law, the vast majority of Canadian corporations are uniquely numbered.

[2]The origins and function of the "[Name] Club" naming convention appear to have generated misunderstanding by the courts below – which these courts had every opportunity to avoid and did not. Accordingly, we elaborate on these matters briefly in the Statement of the Case, p.14, below.

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Cases (cont'd)

Bailey v. Transportation-Communication Employees Union, 45 F.R.D. 444 (N.D. Miss. 1968) . . . . . -26-

Bailey v. Turbine Design, Inc., 86 F. Supp. 2d 790 (W.D. Tenn. 2000) . . . . . -29-

Barrett v. Catacombs Press, 44 F. Supp. 2d 717 (E.D. Pa. 1999) . . . . . -29-

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Bochan v. LaFontaine, 68 F. Supp. 2d 692 (E.D. Va. 1999) . . . . . -29-

Burnham v. Superior Ct. of Cal., 495 U.S. 604 (1990) . . . . . -19-, -22--25-

Cello Holdings, LLC. v. Lawrence-Dahl Cos., 89 F. Supp. 2d 464 (S.D.N.Y.2000) . . . . . -29-

Chase Nat'l Bank v. Turner., 269 N.Y. 397, 199 N.E. 636 (1936) . . . . . -29-

Coastal Video Comm'ns Corp. v. Staywell Corp., 59 F. Supp. 2d 562 (E.D.Va. 1999) . . . . . -29-

Dagesse v. Plant Hotel N.V., 113 F. Supp. 2d 211 (D.N.H. 2000) . . . . . -29-

Cases (cont'd)

Diamond v. Earle, 217 Mass. 499,
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E-Data Corp. v. Micropatent Corp.,
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ESAB Group, Inc. v. Centricut, LLC,
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Euromarket Designs, Inc. v. Crate & Barrel Ltd.,
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Fernandez v. McDaniel Controls, Inc.,
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Ford Motor Co. v. Great Domains, Inc.,
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Frier v. Terry, 230 Ark. 302,
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GTE New Media Servs. v. Bellsouth Corp.,
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Cases (cont'd)

Hornell Brewing Co. v. Rosebud Sioux Tribal Court,
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Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc., 515 U.S. 557 (1995) .... -iv-, -31-

In re Equitable Plan Co.,
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In re Healey, 53 Vt. 694,
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In re Thompson, 122 Mass. 428, 1877 WL 10168,
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Inset Systems, Inc. v. Instruction Set, Inc.,
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International Plastic Harmonica Corp. v. Harmonic Reed Corp., 69 F. Supp. 515 (E.D. Pa. 1946) ..... -26-

K2r Produkte AG v. Jeremie Trigano,
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Kelly v. Pennington, 78 Colo. 482,
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LaCroix v. American Horse Show Ass'n,
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Cases (cont'd)

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Madsen v. Women's Health Ctr., Inc.,
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Maritz, Inc. v. Cybergold, Inc.,
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May v. Shumway, 16 Gray 86, 82 Mass. 86,
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McDonnell-Douglas Corp. v. Green,
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Millennium Enters., Inc. v. Millennium Music, LP,
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Molnlycke Health Care, AB v. Dumex Medical Surgical Prods., Ltd., 64 F. Supp. 2d 448 (E.D. Pa. 1999) .... -29-

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Neogen Corp. v. Neo Gen Screening, Inc.,
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Cases (cont'd)

New Kids on the Block v. News Am. Publishing,
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Northern Light Technology v. Northern Lights Club,
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Northern Light Technology, Inc. v. Northern Lights Club,
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Page Co. v. MacDonald,
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Peet v. Fowler, 170 F. 618 (C.C. Pa. 1909) ..... -26-

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Reno v. American Civil Liberties Union,
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Rothschild Berry Farm v. Serendipity Group LLC,
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Cases (cont'd)

Search Force, Inc. v. DataForce Intern., Inc.,
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Shaffer v. Heitner, 433 U.S. 186 (1977) ..... -19-, -24-

Shapiro & Son Curtain Corp. v. Glass,
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Simon & Schuster, Inc v. Crime Victims Bd. of N.Y.,
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Singer v. Reising, 154 Misc. 239,
276 N.Y.S. 714 (N.Y. Mun. Ct. 1935) ..... -26-

Soma Medical Intern. v. Standard Cht'd Bank,
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Sports Authority Michigan, Inc. v. Justballs, Inc.,
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Stewart v. Ramsay, 242 U.S. 128, 129 (1916). ..... -28-

Tasini v. New York Times Co.,
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Valley Bank & Trust Co. v. Marrewa,
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Cases (cont'd)

Viking Penguin, Inc. v Janklow,
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Walker v. Armco Steel Corp.,
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Weber-Stephen Prods. Co. v. Armitage Hardware Co.,
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Wilson v. Garcia, 471 U.S. 261 (1985) ..... -27-

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Winfield Collection, Ltd. v McCauley,
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U.S. CONST. amend. 14, § 1. ..... -3-

U.S. CONST. amend. 5 ..... -3-

Other Authorities

Hague Conference on Private International Law, Preliminary Draft Convention on Jurisdiction In Civil And Commercial Matters (Oct. 30, 1999), *published at* < http://www.hcch.net/e/conventions/draft36e.html > . -23-

Mark A. Lemley, *The Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999) ..... -12-13-

Recent Case: Civil Procedure – D.C. Circuit Rejects Sliding Scale Approach to Finding Personal Jurisdiction Based on Internet Contacts – GTE New Media Services Inc. v. Bellsouth Corp., 113 HARV. L.R. 1128 (2000) ..... -30-

IN THE

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NORTHERN LIGHTS CLUB, 641271 ALBERTA, LTD., d/b/a NORTHERN LIGHTS CLUB, AND JEFFREY K. BURGAR,
Petitioners

v.

NORTHERN LIGHT TECHNOLOGY, INC.

On Petition For Writ Of Certiorari
To The United States Court Of Appeals For The First Circuit

PETITION FOR WRIT OF CERTIORARI

Petitioners Jeffrey K. Burgar and 641271 Alberta, Ltd., d/b/a Northern Lights Club, respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the First Circuit in this case.

Opinions and Orders Below

The opinion of the court of appeals (App., *infra*, 1a-19a) is reported at 236 F.3d 57. The order of the court of appeals denying Appellants' petition for rehearing and suggestion for rehearing *en banc* (App., *infra*, 20a) is unpublished. The opinion of the district court dated March 31, 2000 (App., *infra*, 41a-90a), is reported at 97 F. Supp. 2d 96.

Other opinions, orders, and hearing transcripts potentially relevant to the resolution of this case are unreported. Full citations (and, where applicable, appeals court Joint Appendix references) for each of these documents may be found in the

margin.[3]

Basis for Jurisdiction

The basis for review by writ of certiorari to the United States Court of Appeals for the First Circuit is 28 U.S.C. § 1254. The date of the judgment of the United States Court of Appeals for the First Circuit was January 8, 2001. The date of entry of the order denying Appellants' Petition for Rehearing and Suggestion for Rehearing *En Banc* was January 30, 2001. The Court of Appeals had jurisdiction under 28 U.S.C. § 1292(a)(1) because the appeal was from a March 31, 2000 interlocutory Order of the United States District Court for the District of Massachusetts, granting, continuing, modifying, refusing or dissolving or refusing to dissolve or modify a preliminary injunction. The trial court's subject-matter jurisdiction was based on 28 U.S.C. §§ 1331 and 1338(a), because the plaintiff asserted claims arising under a United States statute – namely, the Lanham Trademark Act (as amended). No notifications under Rule 29.4(b) or (c) are believed to be necessary.

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[3] *Northern Light Technology, Inc. v. Northern Lights Club*, No. 00-1641, 236 F.3d 57, 57 U.S.P.Q.2d 1277 (1st Cir. 2001).

Order Denying Petition for Rehearing and Suggestion For Rehearing *En Banc*, *in Northern Light Technology, Inc. v. Northern Lights Club*, No. 00-1641 (1st Cir. Jan. 30, 2001).

Northern Light Technology v. Northern Lights Club, Civ. A. No. 99-11664-DPW, 97 F. Supp. 2d 96 (D. Mass. Mar. 31, 2000).

Further Scheduling Order (Setting Jan. 19, 2000 Hearing) (Nov. 18, 1999) (Dkt. #65) (C.A. J. App. 174-75), *in* [*NLT*], No. 99-11664 (D. Mass. *filed* Aug. 5, 1999).

Temporary Restraining Order (Sept. 2, 1999) (Dkt. No. 28) (C.A. J. App. 174-75), *in* [*NLT*], No. 99-11664 (D. Mass. *filed* Aug. 5, 1999).

Transcript of Hearing (Jan. 19, 2001) (Dkt. No. 98) (C.A. J. App. 402-435), *in* [*NLT*], No. 99-11664 (D. Mass. *filed* Aug. 5, 1999).

Transcript of Hearing (Jan. 21, 2001) (Dkt. No. 99) (C.A. J. App. 436-513), *in* [*NLT*], No. 99-11664 (D. Mass. *filed* Aug. 5, 1999).

Constitutional Amendments, Statutes and Rules Involved

The First Amendment to the United States Constitution provides, in relevant part, "Congress shall make no law . . . abridging the freedom of speech or of the press." U.S. CONST. amend. 1

The Fifth Amendment to the Constitution provides, in relevant part, "No person shall . . . be deprived of life, liberty, or property, without due process of law . . . ." U.S. CONST. amend. 5

The Fourteenth Amendment provides, in relevant part, "No State shall . . . deprive any person of life, liberty, or property, without due process of law; nor deny to any person within its jurisdiction the equal protection of the laws." U.S. CONST. amend. 14, § 1.

The Anticybersquatting Consumer Protection Act of 1999 provides, in relevant part, "(ii) Bad faith intent described under subparagraph (A) shall not be found in any case in which the court determines that the person believed and had reasonable grounds to believe that the use of the domain name was a fair use or otherwise lawful." 15 U.S.C. § 1125(d)(1)(B)(ii).[4]

28 U.S.C. § 1292 provides, in relevant part, "(a) . . . [T]he courts of appeals shall have jurisdiction of appeals from: (1) Interlocutory orders of the district courts of the United States . . . or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to dissolve or modify injunctions, except where a direct review may be had in the Supreme Court . . . ."

The Rules of Decision Act provides, in relevant part, "The laws of the several states, except where the Constitution or treaties of the United States or Acts of Congress otherwise require or provide, shall be regarded as the rules of decision in civil actions in the courts of the United States, in cases where

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[4]The full text of 15 U.S.C. § 1125, as amended is set forth in the Appendix. (App., *infra*, 21a - 29a).

they apply." 28 U.S.C. § 1652.

Rule 4 of the Federal Rules of Civil Procedure,[5] in relevant part, provides:

> **Fed. R. Civ. P. 4. Summons.**[6] . . .
>
> (e) **Service Upon Individuals Within a Judicial District of the United States.** Unless otherwise provided by federal law, service upon an individual from whom waiver has not been obtained and filed, other than an infant or incompetent person, may be effected in any judicial district of the United States:
>
> (1) pursuant to the law of the state in which the district court is located, or in which service is effected, for the service of summons upon the defendant in an action brought in the courts of general jurisdiction of the State; . . .
>
> (k) **Territorial Limits of Effective Service.** (1) Service of a summons or filing of a waiver of service is effective to establish jurisdiction over the person of a defendant
>
> (A) who could be subjected to the jurisdiction of a court of general jurisdiction in the state in which the district court is located . . .

FED. R. CIV. P. 4(e)(1), 4(k)(1)(A).

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[5]The full text is set forth in the Appendix. (App., *infra*, at 30a - 40a).

[6]**Notes of Advisory Committee on 1993 Amendments:** . . . .

Note to subdivision (e). This subdivision replaces former subdivisions (c)(2)(C)(1) and (d)(1). It provides a means for service of summons on individuals within a judicial district of the United States. Together with subdivision (f), it provides for service upon persons anywhere, subject to constitutional and statutory constraints.

Service of summons under this subdivision does not conclusively establish jurisdiction of the court over the person of the defendant. A defendant may assert the territorial limits of the court's reach set forth in subdivision (k), including the constitutional limitations that may be imposed by the Due Process Clause of the Fifth Amendment. . . .

FED. R. CIV. P. 4(e) advisory committee's 1993 note.

Statement of the Case[7]

Companies sometimes have personalities. Northern Light Technology ("NLT") does. NLT attempts to differentiate itself from better-known, more useful search engines[8] with the promise (presumably seductive to certain kinds of people) to "organize, categorize, and systematize" the diverse and multitudinous information on the global Internet, into "neat little blue folders."[9] This invites two obvious questions:

(1) Can the Internet – with content "as diverse as human thought"[10] – be shoehorned into "neat little blue folders?," and

(2) Does it want to be stuffed into "little blue folders?"

As this Court recognized in the heady days of 1997, when the

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[7]The trial court's subject-matter jurisdiction was predicated on 28 U.S.C. §§ 1331 and 1338(a), because the plaintiff asserted claims arising under a United States statute – namely, the Lanham Trademark Act (as amended).

[8]The concept of a "search engine" is discussed in *Reno v. American Civil Liberties Union*, 521 U.S. 844, 852 (1997) ("*Reno*"). There exist perhaps several dozen competitors in the "search engine" business – all purporting to provide searchable databases of all or most of the content on the Internet (with varying degrees of completeness). The leading search engine today is probably Google, although Yahoo! (technically, an "Index") probably is best-known. Unlike Yahoo!, Google, and Alta-Vista, which have high brand recognition, NLT has abysmal recognition. It is also important to contrast localized, or "site search" functions. Literally millions of different Websites offer localized "site search" capabilities – which are limited in scope to a much tinier sliver of Internet content. Because "site search" boxes are ubiquitous, the difference between "search engines" and "site search" boxes is widely understood and appreciated in Internet circles – even among users who have been "connected" only a couple of weeks.

[9]See USPTO Trademark Application No. 75358047 (*filed* Apr. 26, 1999) (DEAD) ("CUSTOM SEARCH FOLDERS"); see also USPTO Trademark Application No. 76041419 (*filed* May 2, 2000) ("NORTHERN LIGHT" for "Computer . . . search engines . . . which grou[p] search results into folders . . . with similar subjects, sources, or types").

[10]*Reno*, 521 U.S. at 852, 870.

Internet Boom was exploding full force, the Internet is "a unique and wholly new medium of worldwide human communication" that "enable[s] tens of millions of people to communicate with one another and to access vast amounts of information . . . ." *Reno*, at 850.

"Anyone . . . may take advantage of a wide variety of communication and information retrieval methods. These methods are constantly evolving and difficult to categorize precisely." Id. at 851. However, email and the World Wide Web are by now familiar.[11] Id. at 851-52. "Taken together, these tools constitute a unique medium – known to its users as 'cyberspace' – located in no particular geographical location but available to anyone, anywhere . . . ." Id. at 852.

The Internet is the "Marketplace of Ideas" on steroids. "[A]t any given time, '[hundreds] of thousands of users are engaging in conversations on a huge range of subjects.'" Id. "Any person or organization with a computer connected to the Internet can 'publish' information. Publishers include government agencies, educational institutions, commercial entities, advocacy groups, and individuals." Id. at 853. "This dynamic, multifaceted category of communication includes not only traditional print and news services, but also audio, video, and still images, as well as interactive, real-time dialogue. Through the use of chat

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[11]Judge Stahl's oversimplification and seeming belief and that Domain Names have no other function than email and the 'Web (see App., *infra*, at 3a n.1), however, is incorrect. Several other statements by the courts below – such as speculative talk about so-called "'entice[ment]' of users to post material" (see App., *infra*, at 7a (citing 97 F. Supp. 2d at 104-06), 57a, 59a) – also have no record support. Neither party ever suggested such a feat is possible – which only makes sense, because it isn't. Setting aside the trivial case of a computer "cracker" committing a felony by "breaking into" an unsecure Website server – ordinary Website visitors cannot (usually, even "crackers" cannot) post advertisements, links, or any other content. The opinions below also reflect some lack of appreciation (even though fairly detailed explanation was provided) of how advertising works on the Internet.

rooms, any person with a phone line can become a town crier . . . . Through the use of Web pages, mail exploders, and newsgroups, the same individual can become a pamphleteer. . . . '[T]he content on the Internet is as diverse as human thought.'" Id. at 870.

Given NLT's evident focus on control (stuffing the Internet into blue folders) it should hardly be surprising that NLT wants to control the speech of others – using the courts, if possible, as a mechanism for content control. In this case, what NLT seeks to control is a Website belonging to somebody else.

The publishers of the www.NorthernLights.com Website – which was launched first and was in active use for almost a year prior to the NLT search engine – evidently rub the CEO of NLT the wrong way. NLT (the latecomer) wants to own (and control the content of) both Websites, rather than co-existing and learning to live with the Internet's diversity of expression. If NLT really meant to co-exist peacefully, then it would have resolved this case in July, 1999, when Defendants made overtures to do so. Defendants were willing – as their counsel told NLT (the trial court was also told repeatedly) – to compromise by removing the localized "site search" box that NLT has decried so vociferously.[12] Defendants also offered to

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[12]Nevertheless, the trial court piles blame upon Defendants for the notion that they "made little or no effort to curtail their allegedly infringing activity." *See* App., *infra*, 55a. But the Defendants did offer to modify the Website, if that would resolve the dispute. The Plaintiff is the party that has consistently blocked all progress. (Defendants' pre-litigation overtures to open discussions about compromise are in the record). NLT has repeatedly (even prior to the lawsuit) rejected any outcome other than outright transfer of control. Thus – since NLT consistently refused to negotiate – it is NLT that bears sole blame for the posture of the case at the September 1, 1999 hearing. Moreover, at the Sept. 1, 1999 hearing, Defendants volunteered unilaterally to add a disclaimer and to remove both "allegedly infringing" elements from the site – the "search box," and the hyperlink. The Defendants also made these changes unilaterally. Only NLT has made "no effort."

change the content back to its pre- April 4, 1999 state. The only party blocking resolution and compromise has been NLT, which continues to insist on forcing a sale – even though Defendants do not want to sell. In reality, all this nonsense about a "search box" and a hyperlink is pure pretext: NLT's agenda is complete domination, not reasonable compromise.[13]

NLT admits it has coveted[14] the Domain Name NorthernLights.com since July 1996. Not only did NLT attempt to negotiate the purchase of NorthernLights.com in March 1999 – after USA Today spelled NLT's name wrong,

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[13]Notably, NLT's attitude about its own purported "intellectual property" rights differs markedly from its position concerning the IP rights of others. NLT has been sued in several cases by freelance writers – most of which have been consolidated in the Southern District of New York. While the cases raise some issues similar to *Tasini v. New York Times Co.*, 206 F.3d 161 (2d Cir. 2000), *cert. granted*, 121 S. Ct. 425 (2000), the Northern Light case is even more egregious than *Tasini* because NLT collects pay-per-copy fees when it republishes so-called "Special Collection" documents. NLT collects these fees on a per-document basis – without sharing any revenue with copyright-owning freelance writers – when NLT (sometimes knowingly) sells unauthorized copies of writers' works.

[14]The reason for coveting this name is simple – serendipity. Users who type addresses this navigation method works when returning to Websites (bookmarks work better), but it is haphazard at best when venturing into and exploring new territory. In fact, most know only to expect surprises – for nobody entirely can predict what will be found at any previously un-visited address. But this haphazard quality of stumbling upon the unexpected – the serendipity of discovery – is exactly what makes this method of navigation so attractive. NorthernLights.com is the kind of domain name that a lot of people type, expecting to be surprised.

NLT's revenue stream is principally a function of "hits" or "eyeballs" – and the more new visitors that stumble across the NLT website, then the more regular customers NLT ultimately hopes to win. (Presumably, any repeat visitors who type an "s" by mistake recognize and correct the mistake instantly and with ease.) Since NorthernLights.com generates "serendipity" traffic, NLT views it as a rich source of potential new customers to be introduced for the first time to NLT's services.

but NLT also sought to buy it in June, 1996[15] (even before any of the Defendants registered NorthernLights.com). Mr. David Seuss, NLT's CEO has testified that he called the registrant for this domain name (necessarily a prior registrant)[16] about a purchase inquiry in 1996. Evidently, NLT did not acquire the name because the prior registration lapsed sometime in October, 1996, and Defendant 641271 Alberta Ltd., registered NorthernLights.com on October 31, 1996.

The NorthernLights.com Website was activated in November, 1996 – about five months prior to the argument in *Reno v. ACLU*. It was not until August 1997 – about three months after the *Reno* opinion was issued – that the NLT "re"search engine opened for business. In short, Defendants certainly were unaware of Plaintiff and its search engine at the time NorthernLights.com was registered.

From November 1996 continuously through April 4, 1999, the NorthernLights.com Website was active and consisted of the identical Website "homepage" as < www.FlairMail.com >, because FlairMail was the licensee of this domain name (and

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[15]NLT Employee Charles Snow confirms that Mr. Seuss did not, in fact, talk to Mr. Burgar, but instead with a prior registrant located in New York.

[16]Importantly, that prior registrant is not a party to this lawsuit and any statements allegedly made by that stranger cannot be attributed to anyone in this lawsuit. See 94 F. Supp. 2d at 102 n.9 (App., *infra*, at 50a). Defendant 641271 Alberta, Ltd. d/b/a Northern Lights Club was the third registrant, historically, for this name. Given Judge Woodlock's footnote 9, his subsequent reliance on Seuss's testimony as evidence of and Defendant's "bad faith intent" in this case simply defies reasoned analysis. See App, *infra*, 84a. The trial court's reference to a settlement letter (App., *infra*, at 85a) is also wrong. As Judge Woodlock clearly knows (but has omitted), the face of this particular letter clearly says the Defendants were disinclined to sell at any price, but in response to an inquiry initiated by the Plaintiff, would not foreclose this avenue of negotiation. However, Defendants refuse to be browbeaten into a forced sale.

several others),[17] and because this arrangement made it easier for new [myname]@NorthernLights.com vanity email subscribers, to locate the sign-up page, as well as for existing subscribers to access their accounts.

The Domain Name < NorthernLights.com > was registered for precisely the same reasons as < AbominableSnowman.com >, < LochNessMonster.com >, and a number of other "catchy" domain names:[18] (1) these are good addresses to offer for free email subscribers, and (2) over the long run, they may be good addresses to construct different Websites. If one wants to build a Website using such an address, one cannot wait to register. Under the first-come-first-served rule of Domain Name allocation, somebody else will register it long before you do.

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[17] E.g., [myname]@skifan.com, sbrever@northernlights.com, nscalia@chooselife.com, wrehnquist@booklover.com, or gbush@theovaloffice.com. 641271 Alberta, Ltd., licenses a some of these Domain Names to a separate company called FlairMail, that provides personalized "vanity" email addresses for subscribers.

[18] Contrary to certain language in the First Circuit's opinion (seeking to redefine "catchy" in a peculiar way), "catchy" names are specifically selected not to reflect any trademarks. Examples of "catchy" domain names include: artlovers.com, camera-expert.com, booklover.com, movielovers.com, aquarius1.com, scorpio1.com, baseballcrazy.com, golfcrazy.com, duffers.com, ottawa1.com, texas1.com, chooselife.com, countrygal.com, redhot1.com, and hermajesty.com. They involve no trademarks, but may be attractive for vanity email addresses, or – over the longer term – may be interesting Website "locations." Granted, in some "fair use" categories, see note 22, *infra* – 641271 Alberta or other entities have registered a limited number of domain names that reflect or incorporate trademarks. For example, a handful of registrations were done by or on behalf of authorized dealers of merchandise (e.g., Mr. Burgar's daughter is authorized to sell Hewlett-Packard printers at her bookstore and HP, from 1985 through 1996, used only < HP.com > and no other address). See *Weber-Stephen Prods. Co. v. Armitage Hardware Co.*, D2000-0187 (WIPO May 11, 2000). However, Mr. Burgar could, in 1996 – if he were really following the "script" posited by Judge Stahl – have registered thousands of trademark-identical Domain Names. He specifically chose **not** to do so.

Nevertheless, the First Circuit's opinion, dripping with condescension, labels Mr. Burgar[19] a "self-described" Internet entrepreneur – as if to suggest he isn't really an Internet Entrepreneur. In reality, he is an Internet entrepreneur. Mr. Burgar is one of the original four investors in Internet North – an internet service provider ("ISP") – as well as the man in charge of its day-to-day operations. This company, very early on, brought dial-up Internet access to a large part of central and northern Alberta. Mr. Burgar also has a Website design firm, a consultancy business,[20] and several other, separate Internet-related businesses. In short, he is one of the visionaries who contributed (at least in a modest way) toward building out the infrastructure and fueling the explosion of diverse expression that flourished between approximately 1993 (when Tim Berners-Lee released the protocols for the World-Wide Web to the world without charging any royalties) and sometime in 1999 or early 2000, when things started changing considerably.

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[19]Jeffrey K. Burgar is a newspaperman by trade and manages several newspapers in northern Alberta. An elected public official in his hometown of High Prairie, he is a pillar of his community. In addition to Internet ventures, Mr. Burgar has also been involved as an investor or a manager of several other enterprises – cable television, a computer store, a tavern, and an automobile dealership, among other projects. He and his wife have two children – one a grown adult and the other in elementary school.

[20]For example, Mr. Burgar is an independent consultant for Nova-Scotia based < www.CanSell.com >, a classified advertising site that is not a party to this litigation in any way. It just so happens that Mr. Burgar – when he declined to sell NorthernLights.com to NLT, also informally probed on behalf of CanSell (and not any Defendant) about the availability of a software license. The licensing inquiry was promptly rejected. Therefore, the licensing inquiry is no basis for Massachusetts jurisdiction. "My company" to which Mr. Burgar refers, when misquoted by Judge Woodlock (App., *infra*, 56a) is unambiguously CanSell, and not any other entity – certainly **not** NorthernLights.com (despite Judge Woodlock's effort to conflate the two). Accordingly, this quotation cannot possibly serve as any basis for Massachusetts jurisdiction.

Defendants respectfully disagree with the First Circuit's effort to redefine the "catchy" subcategory of domain names,[21] as something else entirely. The contention that "catchy" means "i.e., Internet addresses appropriating, in identical or slightly modified form, the names of popular people or organizations," (App., *infra*, 3a, 16a), is roughly akin to arguing that the population of Boston is – *by definition* – comprised entirely of the physically handicapped, based only upon the observation one day of three or four persons in wheelchairs (out of hundreds encountered). Although no domain names "appropriate" anything, it is true that a small handful[22] of addresses (e.g.

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[21]This "catchy" or "generic" category of domain names (NorthernLights.com is clearly in this category) – is not about trademarks. Ownership by 641271 Alberta, Ltd., of a fair number Domain Names is no more blameworthy than Procter and Gamble's project of "warehousing" catchy domain names (although P&G probably has secured a much larger number). P&G has thousands of domain names such as sinus.com, thirst.com, and flu.com. Moreover, P&G has not put most of them to use. Recently, it has sought to arbitrage several for a profit. Mr. Burgar, in contrast, has worked hard to avoid arbitrage and has actually put "generic" domain names such as LochnessMonster.com, AbominableSnowman.com, and NorthernLights.com, to constructive use by sharing them for free with others.

[22]Separately, either 641271 Alberta, Ltd., or one or more other corporations (all formalities are properly observed) have independently registered some domain names in categories other than "generic" or "catchy" that (at least as things stood in 1996) were evaluated in reference to traditional principles of "fair use." For example, a separate corporation (not 641271 Alberta) is the registrant for about 40 names corresponding with individual celebrities, which have carefully been used in a manner consistent with established fair use principles. See New Kids on the Block v. News Am. Publishing, 971 F.2d 302 (9th Cir. 1992); Springsteen v. Burgar, No. 2000-1532 (WIPO Jan. 25, 2001),<http://arbiter.wipo.int/domains/decisions/html/2000/d2000-1532.html >. Extraordinary effort has been made not to infringe any trademark. The sports names (the case involving these has already been settled) were used with great care to remain clearly within the fair use (continued...)

about 40 "celebrity" names[23] belonging to a corporation other than 641271) – compared with roughly 2000 of the generic golflover / bassangler / booklover variety – do have a trademark-referential aspect to them. However, overemphasis on a few names, without attention to the overall picture, combined with inattention to issues such as fair use, is hardly a methodology for presenting a fair and unbiased assessment of the facts.

Finally, Judge Stahl's hypothesis that the "[Name] Club" convention involved some nefarious scheme to "present a mantle of legitimacy in their registration requests to NSI," (App., *infra*, 15a), is preposterous. There can hardly be a need to "fool" a gatekeeper, when nobody is serving any such "gatekeeping" function. Even at present, NSI pays no attention

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[22](...continued)
doctrine. See, e.g., Mark A. Lemley, *The Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1696, 1706-09 (1999). Nevertheless, principle can be expensive. The sports teams have used litigation to drive several free services (not just FlairMail, but several dozen companies) out of the marketplace. Now, fans must pay monopoly rents for the same services. Consumer protection? We think not. Transfer of the sports names has been bad for customers and fans.

[23]Considerable effort has gone into developing content – including expressive opportunities – for fans, in connection with a small collection of "celebrity" names. See < http://www.celebrity1000.com/celebritysites/ >. Such an investment of time and money is hardly the "modus operandi" of somebody interested in *arbitrage*, as opposed to preserving the important value of diversity on the Internet. In the past year, a surprising number of large entertainment companies have gone out of their way to monopolize ".com, .net, and .org" sets of domain names – which essentially prevents any other independent speaker (e.g., fans) from having anything resembling an equivalent opportunity to reach a potential audience. In short, the extraordinary thing about the Internet in 1996 was the leveling of the communications hierarchy of the past several decades, and a return to a less-centralized marketplace of ideas. The hierarchy is rapidly returning, however, with detrimental consequences for democratic free expression.

and registers everything (with the exception of a few "naughty words"). When the domain name registration system was set up, the process of providing addresses was entirely about billing – not law enforcement, not trademarks, not enabling criminals to stalk people who publish their personal addresses, and not service of process. It was about enabling NSI to collect as much money in renewal fees as possible. Period.

And, consistent with this billing function, and standards that applied in 1996, there is a real benefit to having a U.S. (as opposed to Canadian) mailing address – renewal bills are more likely to arrive without getting lost or returned for lack of postage – preventing cancellation of names for failure to pay for renewal. Moreover, the "[Name] Club" convention has the added benefit of facilitating renewal payments because the names of billing addressees clearly identify which names require renewal. Finally, a temporary software problem with NSI's billing systems made it preferable for record-keeping purposes to register each Domain Name under a unique registrant. Moreover, in this case, when Plaintiff NLT asked **who** the actual legal entity was that owned NorthernLights.com, NLT was given both a street address for service of process and the truthful and correct of the legal owner less than 24 hours after the inquiry was made. Hardly the nefarious "script" Judge Stahl seems to suggest.

Proceedings Below: The posture of this case is somewhat unusual because of the approach the First Circuit took in attempting to dispose of the appeal. The appeal was under 28 U.S.C. § 1292(a)(1), from a March 31, 2000 preliminary injunction order entered by the trial court. The appeal presented three main grounds for reversing the preliminary injunction: (1) the trial court lacked jurisdiction to enjoin the persons of the defendants, (2) the injunction was excessive in scope – **both** due to the traditional balancing done for all injunctions **and** because the injunction clearly violated the First Amendment by imposing too-severe content-based

restrictions on speech, and (3) as a legal matter, the trial court misinterpreted and misapplied the ACPA.

The court of appeals, with great care, saw fit to chart a course designed to avoid addressing **any** of the issues raised on appeal. Instead, it took up some tangential issues interjected by the Appellee's Brief.[24]

The appeals court was evidently less than enamored with the trial court's jurisdiction theory: "Based on this determination we need not reach the alternate bases for personal jurisdiction discussed in the district court's opinion." (App., *infra*, 13a). Instead, it elected to abandon the trial court's theory altogether in favor of a theory based on by in-courtroom service of a second summons on January 19, 2000.

By failing to address important issues (treated at length in the trial court's decision) concerning what the First Circuit described as "the convoluted issues of personal jurisdiction arising from Internet activities," (App., *infra*, 6a) the appeals court essentially used its jurisdictional switcheroo as a vehicle for attempting to dodge questions both about serious defects in the content-forcing injunction entered by the trial court and the split among circuits concerning "Website jurisdiction."

Interestingly enough, the First Circuit did not even bother to get its dates right. The return of service (incidentally, the record contains only one return of service, for one defendant, not three returns see FED. R. CIV. P. 4(b)) was included in the

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[24]The district court expressly declined to consider the validity of personal jurisdiction based on physical service of process. App., *infra*, 61a n.12. "On appeal, however," the First Circuit observed, "plaintiff continues to press its case that, under the doctrine of transient jurisdiction, it has satisfactorily created jurisdiction through its service of process on Burgar prior to the September 1, 1999 hearing." (App, *infra*, 9a).

Appendix[25] and clearly bore the date of January 19, 2000. Nevertheless, the court of appeals repeatedly insists (for some unknown reason) that September 1, 1999 was the special day. See App., *infra*, 5a ("Moments before the district court hearing on September 1, 1999 . . ."), 9a ("just prior to the September 1, 1999 [temporary restraining order] hearing").

While Mr. Burgar was present in the courtroom, prior to the January 19 jurisdiction hearing, and while the judge was on the bench, counsel for the Plaintiff purported to serve a second summons on him. Mr. Burgar had already been served with summons – on August 13, 1999. The original service took place in High Prairie, Alberta, Canada. Mr. Burgar responded to the first summons on August 20, 1999, by filing a timely and proper FED. R. CIV. P. 12(b)(2) personal jurisdiction motion (and other motions) – which personal jurisdiction motion (and supplemental briefing by both parties) was the explicit subject of the January 19 hearing. The trial court on its own morion had noticed the hearing in an order dated November 18, 1999.

Plaintiff's counsel claimed the second summons had been performed in "an abundance of caution," but Judge Woodlock saw things differently: "Efflorescence of chutzpah . . . is probably closer to it." He also remarked: "That doesn't confer jurisdiction; just because you've show[n] up for a hearing." The trial court evidently did not have much faith in the theory that the court of appeals relied upon exclusively as a basis for jurisdiction. The trial court specifically declined to address the issue of in-courtroom service. App., *infra*, 61a n.12.

Prior to January 19, 2000, Jeffrey K. Burgar, a life-long resident of Alberta, Canada, had never previously set foot in Massachusetts. His visit had exactly one purpose – to assert the defense of lack of personal jurisdiction in pending litigation. Mr. Burgar was not present in Massachusetts on a whim. If his

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[25]Pages 400-01 of the Joint Appendix reproduced verbatim the handwritten purported "return of service," which was dated January 19, 1999.

entire purpose was to challenge jurisdiction, his presence certainly cannot constitute "purposeful availment."

Mr. Burgar – both a party and a material witness – had every right to attend a hearing at which his own rights were being adjudicated. It was also clear – and specifically communicated – to the trial court that Mr. Burgar had been present that day to make himself available as a fact witness. There is no dispute that Mr. Burgar's testimony would have been helpful to the trial court because the trial court made some serious mistakes in its Opinion issued on March 31, 2000.

The First Circuit's Failure to Address The Preliminary Injunction "Balancing" and First Amendment Violations: Essentially, the Court of Appeals used the issue of "transient jurisdiction" as a vehicle to bypass and ignore the entire contents of the Defendants-Appellants' Opening Brief. As a result, the trial court's injunction – which unnecessarily forces Defendants to speak content of the plaintiff's choosing – has arbitrarily been left in place.

The whole purpose of permitting interlocutory appeals from injunctions under section 1292 is to make sure that prompt and effective relief is available at the appellate level. The ruling in this case (leaving the injunction in place pending trial) completely subverts this important function.

The appeals court attempts to justify its result by pointing to an "obliqu[e] refer[ence]" at "the critical hearing" – which the appeals court seems to believe was the afternoon hearing on September 1, 1999. However, the order **appealed from** was dated March 31, 2000. In the Order, the trial court specifically ruled on a motion timely filed in mid-September by Defendants,[26] in which First Amendment issues were

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[26]Mr. Burgar's counsel also had previously sought, on November 18, 1999 (on the basis of a lengthy motion filed well in advance of the November hearing), to expedite the dissolution of the trial court's restraining order.

(continued...)

extensively briefed. The trial court had seven months to ponder the First Amendment, with ample briefing by both sides.

The thrust of Defendants' argument is a simple one. The trial court identified three things to change – (1) removal of a "search box," (2) removal of a hyperlink, and (3) posting of a disclaimer. Thus, a narrowly-tailored injunction would have ordered these three things to prevent "confusion," and would have left Defendants otherwise free to express themselves.

Instead, the trial court imposed an unnecessarily severe inunction that commandeered and blacked out the Defendants' **entire** homepage, and replaced it with the text that the Plaintiff had insisted be published there (the Plaintiff's design was essentially a pretext to increase Plaintiff's advertising revenue by cannibalizing as much traffic as possible and diverting it onto Plaintiff's Website). The injunction was emphatically not "narrowly tailored" or the least restrictive means of accomplishing the trial court's objectives. It was calculated to marginalize the speech of the defendants as much as possible.

The trial court was presented with no fewer than **three** less-restrictive alternatives, each of which fully satisfied all of its identified criteria. Nevertheless, it completely failed to provide any rationale whatsoever for failing – on March 31, 2000 – to dissolve or modify its injunction.[27] By ducking this critical

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[26](...continued)
When counsel pressed the court for a ruling at the November hearing, the court first refused to rule – objecting to what it viewed as "an oral motion" (even though a paper motion had been on file for some time). When pressed further, the court left the paper motion for dissolution pending (and set it for a January hearing date), after "denying" the "oral motion" for dissolution.

[27]The trial court's balancing analysis (set forth in its entirety below) completely fails to address any less-restrictive alternatives:

The public interest . . . will best be served in the interim by a solution that
(continued...)

issue entirely, the court of appeals has subverted **the entire purpose** of 28 U.S.C. § 1292(a)(1).

Argument For Granting Certiorari

Overview: For over a decade, this Court has not issued a single opinion addressing personal jurisdiction. The last time the Court took up any issue of personal jurisdiction (specifically, the question of the effect, if any, of *Shaffer v. Heitner*, 433 U.S. 186 (1977), upon the doctrine of "transient jurisdiction"), in *Burnham v. Superior Ct. of Cal.*, 495 U.S. 604 (1990), its effort produced decidedly mixed results. No single point of view commanded a majority of the Court. Therefore, *Burnham*'s holding is confined to the facts of that case.

The Court should grant Certiorari in this case because it requires the Court to consider due process and personal jurisdiction with an eye to both the past and the future – by analyzing both transient jurisdiction (an opportunity to revisit and clarify *Burnham*) and the salient issue of long-arm "Website jurisdiction" in an Internet case. Moreover, in relation to transient jurisdiction, this case presents several important sub-issues of first impression relating to the traditional immunity of parties, lawyers and witnesses from service of process. The circuits are split on the scope of party-lawyer-witness immunity. This Court has not spoken to the subject of process immunity since prior to World War II.

Third, this Petition presents an important question concerning appellate supervision over trial court preliminary injunctions and the purpose of 28 U.S.C. § 1292(a)(1). In this

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[27](...continued)
diminishes the possibility of confusion but nevertheless permits the public access to Defendants' legitimate expression and services. . . . Based upon an evaluation of the several factors relevant to preliminary injunction analysis, I find that the interlocutory relief I have ordered shall remain in place for the remainder of this case.

App., *infra*, at 88a.

case, an appellate court has attempted (despite acknowledging that these issues were properly briefed, timely appealed, and were not waived) arbitrarily to dodge all issues on appeal concerning the scope of an injunction that obviously violates the speech and press rights of a publisher. The First Circuit has attempted to do so by simply remanding for "trial on the merits" without even discussing the daily injury that the content-forcing injunction does to the publishers' speech and press rights, and without even entertaining the possibility of an immediate modification to minimize continuing harm.

Finally, on top of the important and timely issues identified above, this case also presents a novel, important, and timely question of statutory interpretation – namely, what legal framework must courts, plaintiffs and defendants follow in cases under the Anticybersquatting Consumer Protection Act of 1999 ("ACPA"), to make sure that the good-faith "objective reasonableness" defense recognized by Congress is fairly and uniformly applied. If reasonable minds can differ about whether particular Internet-related activity is infringing or "is a fair use or otherwise lawful," then 15 U.S.C. § 1125(d)(2)(B)(ii) clearly says the Defendant gets the benefit of his or her reasonable good-faith subjective beliefs. This only makes sense, because the spirit of bold creativity and experimentation on the Internet – which is precisely what fed the Internet Boom back in 1997 – represents something special that is worth preserving and protecting. Therefore, this Court should make clear: (1) what standard a Defendant must meet to raise this defense, (2) what burden Plaintiff must meet once this defense is raised, (3) what standard the Courts should use in evaluating this defense, and (4) how this issue should be resolved when the record contains evidence that reasonable minds can differ about defendants' good-faith beliefs.

Statutory Interpretation: In 1999, as part of the Omnibus Appropriations Act, Congress passed the ACPA. The ACPA was inserted into the Appropriations Act at approximately 3:06

in the morning the day it was up for a final vote in the House. Parts of the ACPA are calculated to have (and have had since passage) an extraordinary *in terrorem* chilling effect on speech and on Internet commerce – by (1) establishing a vague and unpredictable test for liability involving a "non-exclusive" list of "factors," and (2) permitting plaintiffs to wield the punitive threat of up to $100,000 in statutory damages, in the event that a violation is found. However, wiser heads were not completely excluded from the process. Senator Leahy, among others, insisted upon protections for speech – including traditional principles of "fair use" – that became an integral part of the final legislative product. The ACPA therefore includes an explicit "good faith" defense that Defendants are permitted to invoke. The defense has two elements: (1) a subjective belief that the "use" of an Internet Domain Name is "a fair use or otherwise lawful," and (2) the defendant has "reasonable grounds" for this subjective belief at the time of the "use."

In this case, Defendants have raised the question of what specific steps are required – as a matter of law – in order to mount an "objective reasonableness" defense under the ACPA, as well as the question of what legal analysis applies when such a defense is raised. The First Circuit blatantly dodged this question by mischaracterizing the arguments in Defendants-Appellants' Brief as a factual, rather than a legal inquiry about the trial court's interpretation of 15 U.S.C. § 1125(d)(1)(B)(ii).

It is simply inappropriate to circumvent this defense – as the courts below have done – by denying the very existence of defendants' subjective beliefs instead of considering the objective reasonableness of their actual, subjective beliefs. In this case, the "changing story" vehicle the trial court has sought to employ (much like the story of the blind elders encountering an elephant) depends on the faulty notion that, simply because different aspects of the same defense (none of which are contradictory, all of which are true, and none of which have ever been retracted or "changed") have been emphasized at

different times, nevertheless the "elephant" (the subjective "fair use or otherwise lawful" belief of defendants) does not exist because "an animal cannot be a tree, a snake, a spear, and a wall – all at the same time."

Given the exploding volume of ACPA cases in the lower courts, and the remarkable scarcity of ACPA defendants with the financial resources to shepherd this statutory interpretation question to the Certiorari petition stage,[28] Petitioners respectfully submit that the Court should address this statutory issue in this case. Addressing this issue now will help ensure that the ACPA "objective reasonableness" defense (dismissively termed the "escape clause" by the courts below) remains a robust vehicle for protecting important expressive rights and maintaining a zone Internet freedom, in which creativity and inventiveness are permitted to flourish.

Transient Jurisdiction and *Burnham*: Service-in-the-courtroom certainly was not the original focus of the appeal[29]

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[28]Petitioners, upon request, will be happy to supply the Court with numerous examples of misconduct and abuse by trademark owners. E.g., *K2r Produkte AG v. Jeremie Trigano*, Case No. D2000-0622 (WIPO Aug. 23, 2000), < http://arbiter.wipo.int/domains/decisions/html/2000/d2000-0622.html >(Debevoise & Plimpton Law firm found guilty of "reverse hijacking."); compare Brad Templeton, rec.humor.funny v. MasterCard (Apr. 9, 2001), < http://www.netfunny.com/rhf/jokes/01/Apr/mcrhf.html >, and <http://netfunny.com/rhf/price.html >; with < http://www.rotten.com/legal/desist-mastercard.html >. Almost all Domain Name registrants – even if engaged in clearly non-infringing conduct – tend not to have counsel and often capitulate in the face of threatening "cease-and-desist" letters. A helpful exercise is to use Google or another search engine to review the results of searches for (1) "cease desist letter," "bigfoot letter," and "cease desist trademark." Although each search will pull up well over 10,000 documents, a fair number within the first hundred or so from each search should be instructive.

[29]The issue was not raised in Appellants' Opening Brief, but only in the Appellee's Brief. Defendants, in reply, merely pointed out that the trial (continued...)

but inexplicably it became the focus of the appeals court's opinion. As a result, this case presents an important opportunity to resolve the sharp differences expressed in *Burnham*,[30] and to explain whether:

(1) the Defendant who was served in this case – Mr. Burgar – is immune from "transient jurisdiction" because traditional principles of immunity – as well as deference to Massachusetts law – preclude its application; or

(2) Mr. Burgar is not subject to jurisdiction because – whatever the facts might have been in *Burnham* – this case is different and jurisdiction predicated on in-courtroom "second service" clearly does not pass the "fair play and substantial justice" test.

The *Burnham* case itself did not specifically address the fact pattern involved in this case. Dennis Burnham, a resident of New Jersey, traveled to California – where his estranged wife and the couple's two daughters resided – in January 1988. *Burnham*, 495 U.S. at 607-08. Burnham originally visited the

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[29](...continued)
court expressly chose not to address this issue, identified a number of cases (including many cases turning on process immunity) that supported the view that "second service" in the courtroom should not trigger personal jurisdiction, and pointed out (correctly) that the best course was to remand this issue for further development and briefing. Instead, the First Circuit permitted Appellee to change the subject entirely.

[30]Also relevant to this discussion, and the continuing viability of *Burnham*, are the negotiations presently underway concerning the draft Hague Convention on Jurisdiction and Foreign Judgments in Civil and Commercial Matters. See Hague Conference on Private International Law, Preliminary Draft Convention on Jurisdiction In Civil And Commercial Matters (Oct. 30, 1999), *published at* < http://www.hcch.net/e/conventions/draft36e.html >. All of the major trading partners of the United States strongly object to the *Burnham* transient jurisdiction rule. The Hague Jurisdiction and Judgments Convention is likely to harmonize U.S. law on this point with the governing law in the overwhelming majority of industrial democracies.

Los Angeles area on business, and then traveled north to San Francisco, to visit his children. Id. at 608. After spending the weekend, and upon returning his older daughter home, Mr. Burnham was served with summons for a divorce suit his wife had filed in California state court. Id. The California courts rejected Mr. Burnham's efforts to have the case dismissed for lack of personal jurisdiction. This Court affirmed.

However, the Court was sharply split on the reasons for affirming California's exercise of personal jurisdiction over the vacationing Mr. Burnham. Justice White joined parts I, II-A, II-B, and II-C of Justice Scalia's opinion – but significantly not parts II-D or III. Justice White rejected the view that "as a general proposition . . . the [transient] rule is so arbitrary . . . in so many instances that it should be held violative of due process in every case." Id. at 628. Nor did he view Mr. Burnham's circumstances as affording a viable basis for an as-applied challenge. While Justice White did not rule out the possibility that some other "transient jurisdiction" case could violate due process on an as applied basis, "until such a showing is made, which would be difficult indeed," Justice White saw no need to opine further in *Burnham*. Id.

Justice Scalia, the Chief Justice and Justice Kennedy, however, took the additional step of opining that *Shaffer v. Heitner* does not require an individualized due process determination in each case of "transient jurisdiction" resulting from service upon someone present in the forum. Justice Scalia found support in the historical pedigree of the "transient jurisdiction" rule. Id. at 619-28. Justice Brennan, joined by Justices O'Connor, Blackmun, and Marshall, strongly disagreed with Justice Scalia. Although these four Justices – like Justice White – agreed that the exercise of "transient jurisdiction" on the facts of the *Burnham* case would not violate due process, Justice Brennan's opinion also took Justice Scalia's opinion to task for its methodology. "[R]eliance solely on historical pedigree," according to Justice Brennan, "is foreclosed" by

International Shoe and *Shaffer v. Heitner*, 433 U.S. 177 (1977). *Burnham*, at 629. Justice Stevens, "concerned about [the] unnecessarily broad reach" of the opinions of Justices Scalia and Brennan, "agree[d] that the judgment should be affirmed" in "a very easy case." Id. at 640.

A clear majority of the Court (6 justices in all) in *Burnham* left open the possibility that there might be specific categories of factual circumstances, in which application of the general theory of "transient jurisdiction" runs afoul of due process,[31] because in those specific classes of cases (i.e., service in the courtroom, or when traveling to or from court, upon a party who has entered the forum for no other reason than to press a defense of lack of personal jurisdiction), mechanical application of transient jurisdiction does not meet the standard of "fair play and substantial justice." Burnham, 495 U.S. at 637 n.11, 639 ("The facts of the instant case do not require us to determine the outer limits of the transient jurisdiction rule."); see also Id. at 631-32, nn.4-5 (1990) (Brennan, J., concurring) (citing cases and academic literature).

In this case, the defendant who was served had never previously been to Massachusetts. He had been made a party unwillingly to litigation in Massachusetts. Although the courtroom deputy had been contacted in advance and did not know whether the judge would elect to take testimony or not, it was made clear enough that this Defendant was also a witness who would make himself available under oath if the court required clarification of any facts (and, in fact, it turned out the

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[31]Justice Scalia also does not appear to favor abrogation of traditional exceptions to "transient jurisdiction" – force, fraud, or process immunity, for example – must be abrogated. *Burnham*, 495 U.S. at 613-15. It is not clear from *Burnham* whether he believes the due process clauses reinforce these exceptions (e.g., by prohibiting Congress from passing a statute that authorizes courts to take jurisdiction over foreign persons who are forcibly abducted and transported to the forum).

court did need clarification – even if, on account of a scheduling conflict, the court lacked time to take testimony).

The idea that he could be deprived of **the very defense** that he sought to assert that day – through the artifice of "second service" while the judge was on the bench, simply cannot comport with "fair play and substantial justice."

Numerous courts addressing this exact issue have recognized that "second service" upon a party present to assert the defense of lack of personal jurisdiction, does not enable a court to take jurisdiction over a Defendant. *Bailey v. Transportation-Communication Employees Union*, 45 F.R.D. 444, 447-48 (N.D. Miss. 1968); *Kelly v. Pennington*, 78 Colo. 482, 484, 242 P. 681, 682, 45 A.L.R. 339 (1926); and *Singer v. Reising*, 154 Misc. 239, 240-41, 276 N.Y.S. 714, 715-17 (N.Y. Mun. Ct. 1935). See also *Chase Nat'l Bank v. Turner*, 269 N.Y. 397, 199 N.E. 636, 637 (1936).

The minority – and facially incorrect – view is represented by *LaCroix v. American Horse Show Ass'n*, 853 F. Supp. 992 (N.D. Oh. 1994) (jurisdiction over party and its lawyers premised on service upon lawyers at jurisdiction hearing), on which the appeals court relied.

Further, the overwhelming majority of courts interpreting *Lamb v. Schmitt* conclude that its holding is much narrower than the First Circuit suggests – quite a reasonable view inasmuch as the *Lamb* case arose out of a fact pattern involving fraudulent transfers to a lawyer, in order to avoid a judgment – which clearly differs from the facts of the present case.[32]

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[32]See also Kelly, at 484-85 (" . . . yet the same cases, in stating the general rule, do not limit its application to another or new action, but say that the exemption is from service of civil process in any action."); Shapiro & Son, 348 F.2d at 461 ("Certainly, the mere presence of the relationship is insufficient to dispel the immunity."); Frier v. Terry, 230 Ark. 302, 304 323 S.W.2d 415, 417 (1959); In re Equitable Plan Co., 277 F.2d 319, 321 (2d Cir. 1960) (citing Page Co. v. MacDonald,, 261 U.S. 446 (1923)); Peet v. (continued...)

American Centennial Ins. Co. v. Handal, 901 F. Supp. 892, 895-97 (D.N.J. 1995); *International Plastic Harmonica Corp. v. Harmonic Reed Corp.*, 69 F. Supp. 515, 516 (E.D. Pa. 1946); *Shapiro & Son Curtain Corp. v. Glass*, 348 F.2d 460, 461-62 (2d Cir. 1965); *Fun-Damental, Too v. Hwung*, 1997 WL 289712, at *3-*5 (S.D.N.Y. May 30, 1997); *Viking Penguin, Inc. v. Janklow*, 98 F.R.D. 763, 765-67 (S.D.N.Y 1983); *NASL Marketing, Inc. v. de Vries*, 94 F.R.D. 309, 309-11 (S.D.N.Y. 1982). Contrary to Plaintiff's views on the matter-- Mr. Burgar had every reason to believe that his attendance at the January 19, 2000 hearing rendered him immune from Plaintiff's in-courtroom "second service" stunt.

Moreover, there is no reason to believe that *Lamb*, 285 U.S. 222 (1932), the Mississippi case relied upon so heavily by the circuit court, in any way requires the dramatic and sweeping change in Massachusetts law that the First Circuit suggests. Quite the contrary, Massachusetts law and court precedents should supply the governing rule. 28 U.S.C. § 1652; see also *Wilson v. Garcia*, 471 U.S. 261 (1985); *Walker v. Armco Steel Corp.*, 446 U.S 740 (1980) (diversity case). Under Massachusetts law[33] – including both longstanding state law and federal rulings interpreting and applying Massachusetts

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[32](...continued)
Fowler, 170 F. 618, 619 (C.C. Pa. 1909); In re Healey, 53 Vt. 694, 1881 WL 7823 (1881).

[33]Massachusetts law holds that the formality of seeking or obtaining a court order, authorizing travel into the forum, is not required. *Valley Bank & Trust Co. v. Marrewa*, 354 Mass. 403, 404-05, 237 N.E.2d 677, 678-79 (1968); *Diamond v. Earle*, 217 Mass. 499, 500, 105 N.E. 363, 363 (1914); *In re Thompson*, 122 Mass. 428, 428, 1877 WL 10168, at *1, 23 Am. Rep. 370 (1877); *May v. Shumway*, 16 Gray 86, 82 Mass. 86, 1860 WL 8502 (1860).

law[34] – Mr. Burgar also had every reason to believe on January 19, 2000 that immunity from process was not conditioned upon first moving for a protective order. In Massachusetts,

> [Process immunity] is **not merely a privilege of the person**; it is a prerogative exerted by the sovereign power through the courts for the furtherance of the ends of justice. **Every party has a right to testify in his own behalf.** The rule . . . is extended generally to defendants living outside the state . . . .

Diamond, 105 Mass. at 501 (emphasis added). No Massachusetts court ever has recognized any of the exceptions that the First Circuit sought to establish and apply retroactively in this case.

The proposed "protective order" rule is directly contrary to prior controlling Massachusetts law:

> It has long been settled that parties and witnesses attending in good faith any legal tribunal, **with or without a writ of protection**, are privileged from arrest on civil process during their attendance, and for a reasonable time in going and returning.

Larned v. Griffin, 12 F. 590, 590 (C.C. Mass. 1882) (emphasis added); *Valley Bank & Trust Co. v. Marrewa*, 354 Mass. 403, 404-05, 237 N.E.2d 677, 678-79 (1968); *Diamond v. Earle*, 217 Mass. 499, 500, 105 N.E. 363, 363 (1914); *In re Thompson*, 122 Mass. 428, 428 1877 WL 10168, at *1, 23 Am. Rep. 370 (1877); see also *Stewart v. Ramsay*, 242 U.S. 128, 129 (1916).

Due Process and "Internet Contacts:" The advent of the global Internet requires this Court to re-visit many important issues of personal jurisdiction – several of which are squarely presented in this case. Lower courts have had great difficulty adapting traditional principles of law to resolve evolving Internet-related issues. *See, e.g., Bensusan Restaurant Corp. v.*

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[34] *Larned v. Griffin*, 12 F. 590, 590 (C.C. Mass. 1882) (emphasis added).

King, 126 F.3d 25, 27 (2nd Cir. 1997) (in trademark case, comparing the attempt "to apply established . . .law in the fast-developing world of the [I]nternet" to the difficulty of "trying to board a moving bus").

Particularly on questions of personal jurisdiction, trial and appellate courts have been all over the map.[35] Indeed, the

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[35]Compare, e.g., *Hornell Brewing Co. v. Rosebud Sioux Tribal Court*, 133 F.3d 1087 (8th Cir. 1998) (no jurisdiction based on Internet "contacts"); *Heathmount A.E. Corp v. Technodome.Com*, 106 F. Supp. 860 (E.D. Va. 2000) (no personal jurisdiction), *certified for interlocutory appeal*, No. 01-1153 (4th Cir. Feb. 2, 2001); *America Online, Inc. v. Huang*, 106 F. Supp. 2d 848 (E.D. Va. 2000) (no jurisdiction based on Internet "contacts"); *Winfield Collection, Ltd. v. McCauley*, 105 F. Supp. 2d 746 (E.D. Mich. 2000) (same); *Berthold Types Ltd. v. European Mikrograf Corp.*, 102 F. Supp. 2d 928 (N.D. Ill. 2000) (same); *Search Force, Inc. v. DataForce Intern., Inc.*, 112 F. Supp. 2d 771 (S.D. Ind. 2000) (same); *Dagesse v. Plant Hotel N.V.*, 113 F. Supp. 2d 211, 220 (D.N.H. 2000) (same); *Bailey v. Turbine Design, Inc.*, 86 F. Supp. 2d 790 (W.D. Tenn. 2000) (same); *Perry v. RightOn.com*, 90 F. Supp. 2d 1138 (D. Or. 2000); *Neogen Corp. v. Neo Gen Screening, Inc.*, 109 F. Supp. 2d 724 (W.D. Mich. Aug 21, 2000) (same); *Millennium Enters., Inc. v. Millennium Music, LP*, 33 F. Supp. 2d 907, 910-24 (D. Or. 1999) (same); *Rothschild Berry Farm v. Serendipity Group LLC*, 84 F. Supp. 2d 904, 909 (S.D. Ohio 1999) (same); *Molnlycke Health Care, AB v. Dumex Medical Surgical Prods., Ltd.*, 64 F. Supp. 2d 448 (E.D. Pa. 1999) (same); *Rannoch, Inc. v. Rannoch Corp.*, 52 F. Supp. 2d 681 (E.D. Va. 1999) (same); *Barrett v. Catacombs Press*, 44 F. Supp. 2d 717 (E.D. Pa. 1999) (same); *ESAB Group, Inc. v. Centricut, LLC*, 34 F. Supp. 2d 323 (D.S.C. 1999) (same); *Mallinckrodt Medical, Inc. v. Sonus Pharmaceuticals, Inc.*, 989 F. Supp. 265 (D.D.C. 1998) (same); *Fernandez v. McDaniel Controls, Inc.*, 999 F. Supp. 1365 (D. Haw. 1998) (same); *Edberg v. Neogen Corp.*, 17 F. Supp. 2d 104 (D. Conn. 1998) (same); *E-Data Corp. v. Micropatent Corp.*, 989 F. Supp. 173 (D. Conn. 1997) (same); with *Ford Motor Co. v. Great Domains, Inc.*, No. 00-CV-71544-DT, __ F. Supp. 2d __, 2001 WL 348986 (E.D. Mich. Mar 30, 2001) (inventing fanciful "lexical context" theory of jurisdiction); *Cello Holdings, LLC. v. Lawrence-Dahl Cos.*, 89 F. Supp. 2d 464 (S.D.N.Y.2000); *Euromarket Designs, Inc. v. Crate & Barrel Ltd.*, 96 F.Supp.2d 824, 836 (N.D.Ill.2000); *Coastal Video Comm'ns Corp. v. Staywell Corp.*, 59 F. Supp. 2d 562 (E.D.Va. 1999); *Sports Authority* (continued...)

circuits already are split on the issue of the proper legal standard or method of analysis to apply when a plaintiff attempts to assert personal jurisdiction on an "Internet contacts," or "interactive Website" theory. Compare *GTE New Media Servs.*, 199 F.3d 1343, 1349-50 (D.C. Cir. 2000), and *Bensusan Restaurant Corp. v. King*, 126 F.3d 25 (2nd Cir. 1997), with *Mink v. AAAA Development LLC*, 190 F.3d 333 (5th Cir. 1999), and *Soma Medical Intern. v. Standard Chtd. Bank*, 196 F.3d 1292 (10th Cir.1999), and *Zippo Mfg. Co. v. Zippo Dot Com, Inc.*, 952 F. Supp. 1119 (W.D. Pa. 1997). See also *Recent Case: Civil Procedure – D.C. Circuit Rejects Sliding Scale Approach to Finding Personal Jurisdiction Based on Internet Contacts – GTE New Media Services Inc. v. Bellsouth Corp.*, 113 HARV. L.R. 1128 (2000). The lower courts need guidance in this area, and certiorari should be granted in this case in order to provide that guidance.

Scope of the Injunction: On March 31, 2001, the trial court entered an order enjoining (or declining to stop enjoining) the Canadian publisher of a Website unwillingly to publish content of the trial court's choosing – drafted with assistance of Plaintiff NLT. The trial court's March 31 Order contains no rationale for exercising such excessive, sweeping, and unnecessary content control over the Website. Nor does the trial court's opinion identify any justification whatsoever for depriving Defendants of important, non-infringing expressive opportunities, for rejecting alternatives, or for deliberately

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[35](...continued)
Michigan, Inc. v. Justballs, Inc., 97 F. Supp. 2d 906 (E.D. Mich. 2000); *Bochan v. LaFontaine*, 68 F. Supp. 2d 692 (E.D. Va. 1999); *PurCo Fleet Services, Inc. v. Towers*, 38 F. Supp.2 d 1320 (D. Utah 1999); *Zippo Mfg. Co. v. Zippo Dot Com, Inc.*, 952 F. Supp. 1119 (W.D.Pa. 1997) (genesis of "sliding scale" approach); *Inset Systems, Inc. v. Instruction Set, Inc.*, 937 F. Supp. 161 (D. Conn. 1996) (Taking jurisdiction based on "24 hours a day, 7 days a week," Website visibility theory); *Maritz, Inc. v. Cybergold, Inc.*, 947 F. Supp. 1328 (E.D. Mo.1996).

suppressing Defendants' speech and press rights.

The mechanism of suppression selected by the trial court has been to hide Defendants' expression behind a blacked-out "greeting page" that deliberately diverts a substantial portion of Defendants' audience away from the Website before these visitors have a chance to see Defendants' published message.

The injunction is directly analogous to an order permitting Planned Parenthood to distribute leaflets only if those leaflets are enclosed in black envelopes bearing the telephone number of Operation Rescue, or permitting Planned Parenthood to distribute leaflets only if they first erect a gigantic black wall between themselves and their audience, thereafter communicating only with audience members who bother to walk through a door in the wall. The trial court's injunction is hardly the least restrictive means to accomplish the trial court's identified objectives.

Because the injunction dictates the entire substantive content of the Website "homepage," and does so without necessity or a compelling justification, it violatea the prohibition against "forced speech" set forth in such cases as *Wooley v. Maynard*, 430 U.S. 705, 714 (1977), and *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston, Inc.*, 515 U.S. 557, 573 (1995). The injunciton also fails "strict scrutiny, which applies to all content-based regulations. E.g., *Perry Education Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 45 (1983), *Simon & Schuster, Inc. v. Crime Victims Bd. of New York*, 502 U.S. 105, 115-18 (1992). Third, it violates *Madsen v. Women's Health Ctr., Inc.*, 512 U.S. 753 (1994), which requires that all injunctions (even content-neutral ones that only incidentally burden speech) must "burden no more speech than necessary to serve a significant government interest?" Finally, it violates fundamental principles governing allinjunctions.

The Court of appeals clearly shirked its duty under 28 U.S.C. § 1292(a)(1), by dodging these important questions and leaving this speech-suppressing injunction in place.

CONCLUSION

Accordingly, for the reasons set forth above, Petitioners pray that the petition for certiorari be granted, that the judgment of the circuit court be reversed, and that the case be remanded with instructions to dissolve the injunction and to dismiss all claims against defendants for lack of personal jurisdiction.

Respectfully Submitted,

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